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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,788	04/09/2001	Khai Hee Kwan		8886

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AUSTRALIA

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,788

Applicant(s)

KWAN, KHAI HEE

Examiner

Rob Rhode

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 6 and 20 - 33 is/are pending in the application.
- 4a) Of the above claim(s) 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 6 and 20 - 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Newly submitted claim 33 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The invention for new claim 33 does not require two networks nor a centralized payment processor.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 33 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant's amendment of 12-9-04 amended claims 1, 3 – 6, canceled claims 7 - 19 and added new claims 21 - 33 as well as traversed rejections of Claims 1 - 20.

Currently, claims 1 – 6 and 20 - 32 are pending.

Claim Objections

Claims 21 – ~~33~~³² are objected to because of the following informalities: The normal US practice for Independent claims for system and computer executable code, which is identical in wording to the method claim, is to recite the claim again in total. This applies as well to all dependent claims too. Of note, system claims require the appropriate structure in order to carry out the recited steps. .

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 21 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 1, it is not clear who or what is performing the steps as recited. For example, the applicant cites a centralized payment processor and service provider and then further recites receiving, establishing, sending and authenticating. However, it is not at all clear who is doing the receiving, establishing, sending and authenticating. Therefore, determining the metes and bounds of the claims is almost impossible. For examination purposes, the service provided is equated to billing platform and the steps of extending, establishing, sending, an ISP with an authentication service performs authenticating.

Claims 1, 21 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 1, the word "main" is a relative word, which renders the claims indefinite. The word "main" is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes the word "main" will be treated as accounts associated with the transaction for the payee and for the payer.

Claims 6, 26 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 6, it is not clear at all what the step of "checking" is accomplishing since the decryption had to occur in the preceding verifying step. In addition, the word "integrity" is a relative word, which renders the claims indefinite. The word "integrity" is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes, the word "integrity" will be treated as verifying the transaction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 5, 20 – 25, 27 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhill (US 6,934,858 B2) in view of Ronen (US 5,845,267).

Regarding claim 1 (Currently Amended) and related claims 21 and 28, Woodhill teaches a computer network method and system for payment or fund transfer transactions over at least two networks using telecommunication accounts through at least one telecommunication service provider and a wireless communication device comprising:

extending at least one the telecommunication service provider's main processor for establishing sub accounts for both payer and payee on the provider's main processor having a corresponding account identifier to the main telecommunication account (see at least Abstract, Col 4, lines 38 - 46 and Figure1);

receiving the payer's telecommunication account identifier, the transfer amount the payee's telecommunication account identifier upon initiation of a transaction over a first network (see at least Col 4, lines 56 – 67 and Col 5, lines 1 – 54) :

establishing a connection with payer for authentication over a second network different as compared to the first network (Abstract and Figure 1):

sending at least a password by payer over said second network (Col 2, line 33 and Col 4, lines 47 – 55);

authenticating said respective account identifiers and said password linked to the sub-account of payer (see at least Col 6, lines 36 – 51 and lines 57 – 65):

whereby said authentication is satisfied, includes a further step of recording a debit entry for said transfer amount in payer's sub account and a credit entry for same for

payee's sub account: and wherein payer's telecommunication account is a non prepaid account (see at least Col 8, lines 52 – 65 and Table 3, item 12.

Please note and for examination purposes that a telephone was equated to a communication device. Even though the Applicant used the word wireless, the Applicant did not incorporate into the body of the claim. Thereby, wireless was considered as “intended use” and given very little patentable weight. For example, a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In addition, the telecommunications service provider was equated to a service provider. In this case, the word “telecommunications” is considered to be non-functional descriptive material, which was given very little patentable weight (MPEP 2106).

While Woodhill does disclose a payment processor, the reference does not specifically disclose and teach a method and system for providing at least a centralized payment processor linked to the-networks.

On the other hand and in the same area of online payment, Ronen teaches a method and system for providing at least a centralized payment processor linked to the-networks (See at least Abstract, Col 2, lines 55 – 62 and Figure 1).

It would have been obvious to one of ordinary skill in the art to have provided the method and system of Woodhill with the method and system of Ronen to have enabled a method and system as recited in claim 1. Woodhill discloses the steps of extending, receiving, establishing, sending and authenticating (see at least Abstract and figure 1). In turn, Ronen discloses a method and system for providing at least a centralized payment processor linked to the-networks (See at least Abstract, Col 2, lines 55 – 62 and Figure 1). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Woodhill with a method and system for providing at least a centralized payment processor linked to the networks. In this manner, the service provider can include a centralized payment processor to ensure complete tracking of the transaction, which will ensure that account of the payer, is debited and the account of the payee is credited.

Regarding claim 2 (Previously Presented) and related claim 22, Ronen teaches a method according wherein the payment is in the form of monetary units (Table 1).

Regarding claim 3 (Currently Amended) and related claims 23 and 29, Woodhill teaches a method further includes responding with an activation code through a first network and receiving said code from payer through a second network (figure 1).

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Regarding claim 4 (Currently Amended) and related claims 24 and 30, Ronen teaches a method whereby said authentication is satisfied, if the payer's telecommunications account is a prepaid account, includes a further step of verifying the availability of funds satisfying said amount and subject to said verification, the said amount debited from payer's sub account and credited same to payee's sub account (Abstract and Figure 1).

Regarding claim 5 (Currently Amended) and related claims 25 and 31, Ronen teaches a method wherein sub-account including at least a password for access (Col 6, lines 36 – 51 and lines 57 – 65).

Regarding claim 20 and 27, the examiner takes Official Notice that IVR's were old and well known at the time of the Applicant's invention. The Applicant only asserted in the arguments that this was not old and well known in this Application and thereby the same rejection is maintained in light of no substantive arguments.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 26 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Woodhill and Ronen and further in view of Fox (US 6,560,581 B1).

The combination of Woodhill and Ronen substantially disclose and teach the Applicant's invention.

While the combination does disclose a focus on security in online transactions, the references do not specifically disclose a method and system further includes the steps for receiving goods and services comprising receiving and storing an encrypted receipt in payer's wireless communication device; verifying of transaction includes a step of downloading said receipt from the payer's wireless communication device to merchant server and comparing against a copy stored in merchant server; and checking the integrity of the receipt further includes the step of uploading the receipt to the payment processor for decryption.

On the other hand and regarding claim 6 (Currently Amended) and related claims 26 and 32, Fox teaches a method and system further includes the steps for receiving goods and services comprising receiving and storing an encrypted receipt in payer's wireless communication device; verifying of transaction includes a step of downloading said receipt from the payer's wireless communication device to merchant server and comparing against a copy stored in merchant server; and checking the integrity of the

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receipt further includes the step of uploading the receipt to the payment processor for decryption (see at least Abstract and Figures 8 and 9).

It would have been obvious to one of ordinary skill in the art to have provided the combination of Woodhill and Ronen to have enabled a method and system as recited in claim. In turn, Fox discloses a method and system further includes the for receiving goods and services comprising receiving and storing an encrypted receipt in payer's wireless communication device; verifying of transaction includes a step of downloading said 'receipt from the payer's wireless communication device to merchant server and comparing against a copy stored in merchant server: and checking the integrity of the receipt further includes the step of uploading the receipt to the payment processor for decryption (see at least Abstract and Figures 8 and 9). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Woodhill and Ronen with a method and system further includes the for receiving goods and services comprising receiving and storing an encrypted receipt in payer's wireless communication device; verifying of transaction includes a step of downloading said 'receipt from the payer's wireless communication device to merchant server and comparing against a copy stored in merchant server: and checking the integrity of the receipt further includes the step of uploading the receipt to the payment processor for decryption.

Response to Arguments

Applicant's arguments with respect to claims 1 - 20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

571-273-8300

[Official communications; including

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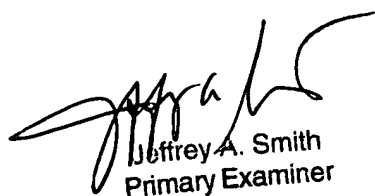
For general questions the receptionist can be reached at

571.272.3600

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Jeffrey A. Smith
Primary Examiner